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EXAMINER

PEPITONE, MICHAEL F

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimer filed on 4/24/08 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 7,099,111 and 7,050,263 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim *et al.* (US 4,912,148), when taken with Westwood *et al.* (US 2008/0188600).

Regarding claim 8: Kim *et al.* teaches a thermoplastic elastomer composition (1:5-16) consisting of an ethylene-propylene-non-conjugated diene copolymer {EPDM}, in an amount of 60 parts by weight (3:38-51; 10:1-25; Table 5, ex 25); polypropylene, in an amount of 40 parts by weight {melt index of 8} (3:52-58; 10:1-25; Table 5, ex 25); paraffinic process oil, in an amount of 15 parts by weight {having a viscosity of 3 to 40 cst at 100 °C (3 to 40 mm²/s at 100 °C; as calculated by examiner); average molecular weight of 320 to 800; and specific gravity of 0.87 to 1.02} (3:59-68; 10:1-25; Table 5, ex 25); and peroxide, in an amount of 0.3 parts by weight (4:18-34; 10:1-25; Table 5, ex 25) {corresponding to 67 parts of polypropylene; 25 parts

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of process oil; 0.5 parts peroxide (based on 100 parts EPDM) [as calculated by examiner]]; the resulting thermoplastic elastomer has a hardness of 70 (Table 5, ex 25).

Westwood *et al.* provides evidence for the viscosity of paraffinic process oils {having specific gravities of 0.877-0.899} when measured at 100 °C {26-31 cst} and 40 °C {376-501 cst}. While Westwood *et al.* does not measure the specific paraffinic process oil of Kim *et al.* (US '148), it does measure paraffinic process oils having similar specific gravity and viscosities at 100 °C (¶ 21 and table illustrative process oils).

Regarding claim 9: Kim *et al.* teaches 20 to 90 parts by weight of ethylene-propylene-non-conjugated diene copolymer {EPDM}, and 5 to 70 parts by weight of crystalline poly-alpha olefin {polypropylene}. While preferred embodiments {Table 5, ex 25} do not disclose 100 parts of crystalline poly-alpha olefin {polypropylene} per 100 parts ethylene-propylene-non-conjugated diene copolymer {EPDM}, the general teaching discloses a 1:1 ratio of crystalline poly-alpha olefin {polypropylene} to ethylene-propylene-non-conjugated diene copolymer {EPDM} (3:15-25), and therefor anticipates the claimed range.

Regarding claim 10: Kim *et al.* teaches the basic claimed composition [as set forth above with respect to claim 8]. The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. a compression set after 168 hours of standing time at 100 °C is 50% or less, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the

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Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claim 11: Kim *et al.* teaches the basic claimed composition [as set forth above with respect to claim 9]. The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. a compression set after 168 hours of standing time at 100 °C is 50% or less, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Seki *et al.* (WO 02/21534). For the purpose of examination, Seki *et al.* (US 2002/0190484) was used as the English translation of Seki *et al.* (WO 02/21534).

Regarding claim 15: Seki *et al.* teaches a gasket (¶ 1, 11, 16-35, 38) having a rounded tip with $R=0.2$ mm or less (¶ 41); the width being 1.5 to 2 mm, and the height to be about 1.5 mm $\{H/W = 0.75 \text{ to } 1\}$ (¶ 40); and an adhesive is used to bond (¶ 42, 44) {Figure 1}.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Oka *et al.* (US 2005/0248101).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claim 15: Oka *et al.* teaches a gasket (¶ 1) having a tip with $R=0.1$ mm or more (¶ 18); the ratio of the height (from tip to main bead), H , and the bonding width of the base, W_0 , is $1.15 < H/W_0 < 1.8$. (¶ 10-13); and an adhesive is used to bond (¶ 20; 77-78) {Figure 1}.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 15 is rejected under 35 U.S.C. 102(a) as being anticipated by Miyake *et al.* (JP 2003-49949). For the purpose of examination, the machine translation of (JP 2003-49949) was used.

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Regarding claim 15: Miyake *et al.* teaches a gasket (§ 1, 13-14) having a tip with $R=0.1$ mm or more (§ 16); the ratio of the height (from tip to main bead), H , and the bonding width of the base, W_0 , is $H/W_0 \geq 0.8$. (§ 16); and an adhesive is used to bond (§ 18; 45) {Figure 1}.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Kim *et al.* (US 4,912,148), when taken with Westwood *et al.* (US 2008/0188600), in view of Matsunaga *et al.* (US 2005/0020740).

Regarding claims 12-14: Kim *et al.* teaches injection molding a thermoplastic elastomer composition (1:5-16; 8:4-5) consisting of an ethylene-propylene-non-conjugated diene copolymer {EPDM}, in an amount of 60 parts by weight (3:38-51; 10:1-25; Table 5, ex 25);

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polypropylene, in an amount of 40 parts by weight {melt index of 8} (3:52-58; 10:1-25; Table 5, ex 25); paraffinic process oil, in an amount of 15 parts by weight {having a viscosity of 3 to 40 cst at 100 °C (3 to 40 mm²/s at 100 °C; as calculated by examiner); average molecular weight of 320 to 800; and specific gravity of 0.87 to 1.02} (3:59-68; 10:1-25; Table 5, ex 25); and peroxide, in an amount of 0.3 parts by weight (4:18-34; 10:1-25; Table 5, ex 25) {corresponding to 67 parts of polypropylene; 25 parts of process oil; 0.5 parts peroxide (based on 100 parts EPDM) [as calculated by examiner]}; the resulting thermoplastic elastomer has a hardness of 70 (Table 5, ex 25).

Westwood *et al.* provides evidence for the viscosity of paraffinic process oils {having specific gravities of 0.877-0.899} when measure at 100 °C {26-31 cst} and 40 °C {376-501 cst}. While Westwood *et al.* does not measure the specific paraffinic process oil of Kim *et al.* (US 4,912,148), it does measure paraffinic process oils having similar specific gravity and viscosities at 100 °C (§ 21 and table illustrative process oils).

Kim *et al.* does not teach a method of forming a gasket by injection molding [instant claim 12], a molded gasket integrally molded with a metal sheet [instant claim 13], or the sealing structure of instant claim 14. However, Matsunaga *et al.* teaches an ethylene- α -olefin copolymer composition suitable for molding (§ 12-13, 22, 24-25, 261). Kim *et al.* and Matsunaga *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of ethylene- α -olefin copolymer composition suitable for injection molding. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined a gasket [instant claim 12] (§ 261), a molded gasket integrally molded with a metal sheet [instant claim 13] (§ 265; 329-330), and utilizing an adhesive to form a sealing structure

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[instant claim 14] (§ 265-266; 329-330), as taught by Matsunaga *et al.* in the invention of Kim *et al.*, and would have been motivated to do so since Matsunaga *et al.* suggests that such molded composition yields a gasket which, when integrated with a cover by an adhesive, can achieve enhanced sealing properties (§ 13), and is an equivalent alternative means of providing a ethylene- α -olefin copolymer composition suitable for injection molding.

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. See attached form PTO-892.

Response to Arguments

Applicant's arguments with respect to claims 8-15 have been considered but are moot in view of the new ground(s) of rejection.

Matsunaga *et al.* (US '740) teaches an ethylene- α -olefin copolymer composition suitable for molding (§ 12-13, 22, 24-25, 261). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pepitone whose telephone number is 571-270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo, Ph.D./
Supervisory Patent Examiner, Art Unit 1796
14-Aug-08

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11-August-08